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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,866	12/06/2001	Vijay Kumar	P04829US1	6560
22885	7590	03/09/2004		
MCKEE, VOORHEES & SEASE, P.L.C.				
801 GRAND AVENUE				
SUITE 3200				
DES MOINES, IA 50309-2721				
			EXAMINER	
			WHITE, EVERETT NMN	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,866

Applicant(s)

KUMAR ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-37 is/are pending in the application.
- 4a) Of the above claim(s) 13-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 7-37 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed October 24, 2003 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claims 1-6 have been canceled;
  - (B) New Claims 36 and 37 have been added;
  - (C) Claims 7-11, 13 and 16 have been amended;
  - (D) Comments regarding Office Action have been provided drawn to:
    - (a) 102(b) rejection, which has been maintained for the reasons of record; however, the rejection over the Diamantoglou patent is withdrawn;
    - (b) 112 2<sup>nd</sup> paragraph rejection, has been withdrawn.
2. Claims 7-37 are pending in the case.
3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 7-12 and 35-37, drawn to an oxidized cellulose ester of formula I or II in Claim 36, classified in class 536, subclass 63.
  - II. Claims 13-34, drawn to a method of making an oxidized cellulose ester, classified in class 536, subclass 124.
5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as oxidized cellulose acetate.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
7. During a telephone conversation with Wendy K. Marsh on February 25, 2004 a provisional election was made without traverse to prosecute the invention of Group I, Claims 7-12 and 35-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Claim Rejections - 35 USC § 112***

9. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 set forth that R is  $(CH_2)_nCOOH$  in formula II. However, formula II of Claim 36 does not set forth an R symbol, which renders the claim indefinite.

10. Applicant's arguments with respect to Claim 36 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

11. Claims 7-12, 36 and 37 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bogan et al (US Patent No. 4,590,265) for the reasons set forth on pages 3 and 4 of the Office Action mailed July 24, 2003.
12. Applicant's arguments filed October 24, 2003 have been fully considered but they are not persuasive. Applicant's insertion of the subject matter of canceled Claim 6 into

newly added Claim 36 which limits the R group thereof to  $(CH_2)_nCOOH$ , does not overcome the rejection of formula II in Claim 36 since formula II of Claim 36 does not contain an R group. Formula II of instant Claim 36 is still anticipated by the cellulose acetate butyrate structure set forth at the bottom of column 6 in the Bogan et al patent when X represents H; when w is less than 1.0; when R' and/or R'' represents  $(CH_2)_nCH_3$ , n is 0 and 2; and when x & y are 0.1-1.9. When n in the formula  $(CH_2)_nCH_3$  is 2, the OCOR' and OCOR'' groups in instant Claim 36 represent the Bu group in cellulose acetate butyrate structure set forth in the Bogan et al patent. When n in the formula  $(CH_2)_nCH_3$  is 0, the OCOR' and OCOR'' groups in instant Claim 36 represent the Ac group in the cellulose acetate butyrate structure set forth in the Bogan et al patent. Accordingly, the rejection of Claims 8-12 and 36 under 35 U.S.C. 102(b) as being anticipated by the Bogan et al patent is maintained for the reasons of record.

13. Claims 35 and 36 stand rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al (US Patent No. 5,973,139) for the reasons set forth on page 4 of the Office Action mailed July 24, 2003.

14. Applicant's arguments filed October 24, 2003 have been fully considered but they are not persuasive. Applicant's insertion of the subject matter of canceled Claim 6 into newly added Claim 36 by limiting the R group thereof to  $(CH_2)_nCOOH$  does not overcome the rejection of formula II of Claim 36 since formula II of Claim 36 does not contain an R group. The Lee et al patent specifically discloses carboxylated cellulose esters prepared from oxidized cellulose that include carboxylated cellulose acetate, carboxylated cellulose acetate butyrate, carboxylated cellulose acetate propionate, carboxylated cellulose propionate butyrate and carboxylated cellulose acetate propionate butyrate, all having structures that fall within the scope of Formula II of Claim 36. See the degree of substitution of the compounds beginning in column 4, line 48 to column 5, line 10. Formula II of instant Claim 36 is still anticipated by the carboxylated cellulose esters set forth in the Lee et al patent when X represents H; when w is less than 1.0; when R' and/or R'' represents  $(CH_2)_nCH_3$ , n is 0, 1 and 2; and when x & y are

0.1-1.9. Accordingly, the rejection of Claims 35 and 36 under 35 U.S.C. 102(b) as being anticipated by the Lee et al patent is maintained for the reasons of record.

### ***Summary***

15. Claims 8-12 and 35-37 are rejected; Claims 13-34 are withdrawn from consideration as being directed to a non-elected invention.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Examiner's Telephone Number, Fax Number, and Other Information***


17. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reach on (571) 272-0661. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
E.White

  
James O. Wilson  
Supervisory Primary Examiner  
**Technology Center 1600**